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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael M. Tso

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909 7590 05/23/2007
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EXAMINER

HAVAN, THU THAO

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

05/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/854,423

Applicant(s)

TSO, MICHAEL M.

Examiner

Thu Thao Havan

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,17-29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, 17-29, and 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 1, 3-15, 17-29, and 31-41 are pending. This action is in response to the remarks received February 22, 2007.

Response to Arguments

The rejection of claims 1, 3-15, 17-29, and 31-41 under 35 U.S.C. 103(a) as being unpatentable by Eggleston et al. (US 6,061,660) and Dethloff (US 4,968,873) is maintained.

Upon a closer examination, Applicant's arguments filed February 22, 2007 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

Applicant alleges that the prior art made of record fails to teach receiving, from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein first currency is a private currency. The examiner disagrees with applicant's representative since Eggleston teaches receiving, from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction, wherein first currency is a private currency (col. 44, line 64 to col. 45, line 67; col. 15, lines 1-56). As specifically stated in the present application, Applicant defines private currency as "*a private currency refers to anything, controlled by a non-sovereign entity, which*

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can be used to "purchase" all or part of some good or service. A vendor is said to "recognize" a private currency if the vendor accepts the private currency as payment, or partial payment, for a good or service. One example of a private currency is "frequent flyer miles" awarded by airlines that may be used in lieu of, or in combination with, legal tender to pay for airfares. As another example, many cereal companies allow children to purchase toys using "proof of purchase" coupons from cereal boxes. As yet another example, many Internet-based companies award points to users for viewing advertisements or visiting particular sites and allow the points to be spent on selected items. In other words, Eggleston discloses a card with userid and password wherein the user obtain incentive points to redeem (i.e. private currency) the award/money at any retails. Thus one retail doesn't necessary recognize another retailers' redemption points but accepts the incentive points due to the points in the card. Thus, he discloses private currency as incentive points for any retailed awards.

With regards to the claims rejected as taught by Eggleston and Dethloff, the examiner would like to point out that the reference teaches the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that Eggleston and Dethloff taught the claimed limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1, 3-15, 17-29, and 31-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 6,061,660) in view of Dethloff (US 4,968,873).

Re claims **1, 15, and 29**, Eggleston teaches a computer-implemented method of processing a transaction (col. 44, lines 40-49), comprising:

receiving, from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction (col. 44, line 64 to col. 45, line 67; Eggleston discloses a card with userid and password wherein the user obtain incentive points to redeem the award/money at any retails. Thus one retail doesn't necessary recognize another retailers' redemption points but accepts the incentive points due to the points in the card), wherein first currency is a private currency (col. 15, lines 1-56; Eggleston discloses private currency as incentive points for any retailed awards);

decrementing an amount of the first currency associated with the first participant, and incrementing an amount of second currency associated with the first participant, wherein the second currency is recognized by the second participant (col. 46, lines 4-55; Eggleston discloses the step of reducing the points in the card as awards are being granted to the user).

However, Eggleston does not explicitly teach processing the transaction using the amount of second currency associated with the first participant. On the other hand, Dethloff discloses processing the transaction using the amount of second currency associated with the first participant (col. 4, line 29 to col. 6, line 49). Dethloff discloses the cardholder or the issuer, after issuance or re-issuance of the card, to assign different values to one unit, change the designations of units and assign additional designation to a unit, all within the

scope of the original extent of terms, and credit values initialized or reissued by the issuer(s). The capabilities of the card, namely to be assignable to sub-users (i.e. participant) and to be alterable as to the values and designations of the stored units, can be provided in individual (single) or in combinational (multi-user-value-card). Thus, it would have been obvious to one of ordinary skill in the art to process the transaction using the amount of second currency associated with the first participant when using a multi-user-value-card to assign different values to a plurality of retailers as discloses in Dethloff.

Re claims **3, 17, and 31**, Eggleston teaches amount of second currency incremented is determined based upon at least the amount of first currency decremented (col. 44, line 64 to col. 45, line 67).

Re claims **4, 18, 32**, Eggleston teaches amount of second currency incremented is determined based upon at least a set of one or more conversion criteria (col. 21, lines 4-28). Eggleston adding or deleting prizes or changing prices or fulfillment options in the incentive points according to user's criteria in receiving the award(s).

Re claims **5, 8, 19, and 33**, Eggleston teaches set of one or more conversion criteria includes a time at which the request from the first participant is received (col. 1, lines 46-62; fig. 9). Eggleston discloses the time is required to keep track of loyalty points earned in each separate incentive program.

Re claims **6-7, 20-22, and 34-36**, Eggleston teaches set of one or more conversion criteria includes one or more attributes of the first/second participant (col. 41, lines 5-38; col. 27, lines 8-34; col. 25, lines 15-49). Eggleston discloses attributes by information and criteria of retailers.

Re claims **9, 23, and 37**, Eggleston teaches set of one or more conversion criteria includes which products or services are involved in the transaction (col. 41, lines 28-65; col. 42, lines 38-57).

Re claims **10-11, 24-25, and 38-39**, Eggleston teaches decrementing an amount of the first currency associated with the first participant includes decrementing a balance of a first currency account associated with the first participant, and the step of incrementing an amount of second currency associated with the first participant includes incrementing a balance of a second currency account associated with the first participant (col. 46, lines 4-55). Eggleston calculations and printed invoices for payment by a financial institution to an incentive company based on the credit instruments issued under the incentive program are made and are dependent upon the monetary volume of expenditures.

Re claims **12-13, 26-27, and 40-41**, Eggleston teaches incrementing the first currency associated with the first participant by the amount of first currency that was previously decremented if the transaction is not successfully processed (col. 21, lines 4-28). Eggleston discloses the retailer may elect to update the award database by adding or deleting prizes or changing prices or fulfillment options.

Re claims **14 and 28**, Eggleston teaches receiving, from the first participant, a request to process a second transaction involving the first participant and a third participant using the first currency that is not recognized by the third participant; decrementing an additional amount of the first currency associated with the first participant; incrementing an amount of third currency associated with the first participant, wherein the third currency is recognized by

the third participant; and processing the second transaction using the amount of the third currency (col. 44, line 64 to col. 45, line 67; col. 46, lines 4-55).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached during her flexitime schedule.

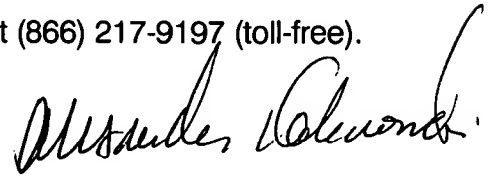
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone

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number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
5/10/2007

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", is written over the printed name and title.

ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER